

Atty Dkt. No.: 10004032-1
USSN: 09/775,375

REMARKS

In view of the following remarks, the Examiner is respectfully requested to withdraw the rejections and allow Claims 1-21, 32 and 33, the only claims pending in this application.

As stated in the Office Action dated September 21, 2004, Claim 9 is drawn to allowable subject matter.

The claims have been amended to specify that the cover strip is non-rigid, support for this amendment being found at least in Figure 2. As this amendment introduces no new matter, raises no new issues and places the claims in condition for allowance, the Examiner is respectfully requested to enter this amendment.

Claim Rejections - 35 USC § 103

The Office Action states that Claims 1 – 8 and 10 - 21 are rejected under 35 U.S.C. § 103(a) as being obvious over Besemer et al. (US 6,140,044) in view of Runyon et al. (US 5,101,975).

With regard to obviousness-type rejections, MPEP § 2142 states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The claimed invention is drawn to microarray strips comprising a pocket strip, microarrays placed in the pockets of the pocket strip, and a non-rigid cover strip that is bonded to the pocket strip thereby generating sealed chambers containing arrays. In making this rejection, the Examiner asserts that Besemer et al. teach "a single microarray packaged in a single sealed chamber by the use of adhesive film" citing column 15, lines 37-48. This passage of Besemer et al. reads as follows:

A cover 2770 is mated to the housing for sealing the cavity. Preferably, cover 2770 is composed of a transparent or translucent material such as glass, acrylic, or other material that is penetrable by light. Cover

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2770 may be mated to surface 2705 with an adhesive 2772, which in some embodiments may be silicone, adhesive film, or other adhesive. Optionally, a depression may be formed around the cavity such that surface 2771 of the cover is at least flush with surface 2705. Alternatively, the cover may be mated to surface 2705 according to any of the chip attachment techniques described herein. (*bold added for emphasis*)

As can be readily seen from this passage, the cover 2770 of the housing disclosed in Besemer et al. is [our first claim doesn't recite an adhesive film"] a rigid material such as glass, acrylic or other material that is penetrable by light. The adhesive film referred to in this passage is not a non-rigid cover strip, but is one embodiment of an adhesive 2772 that secures the cover to the surface 2705. Therefore, Besemer et al. fails to teach or suggest a non-rigid cover strip for sealing the chambers of a microarray holder as is claimed in Claim 1.

The Examiner cites Runyon et al. as filling the deficiencies is Besemer et al. in making the claimed invention obvious. However, as indicated in the previous response and as acknowledged by the Examiner, Runyon et al. do not disclose a carrier chamber that is sealed. The carrier in Runyon et al. is specifically designed to protect electrical components during production, storage and shipping, and having sealed chambers is not one of the elements disclosed.

Therefore, because the combination of Besemer et al. and Runyon et al. fails to teach or suggest each and every element of the claimed invention, they fail to make it obvious.

This distinction over the cited references is particularly pertinent with regard to claims 32 and 33 (added in previously filed amendment and response). Claims 32 and 33 claim rolling the strip of sealed microarray chambers, or "microarray strip", onto a reel. Without a flexible cover for sealing the chambers of the microarray strip, this would not be possible. As such, the Applicants submit that these claims are further distinguished over the cited references. Additionally, neither Besemer nor Runyon teach or suggest a non-rigid polymer or foil laminate cover strip as recited in the claims.

In addition to this, the Applicants reiterate that there is no suggestion or motivation, either expressly or inherently, to combine the cited prior art. As such, the Applicants again maintain, as detailed in the previous response, that the Examiner has relied upon impermissible hindsight in rejecting the claimed invention. For a justifiable rejection under 35 U.S.C. § 103(a) to be made, the invention must be

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viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time, *see Interconnecting Planning Corp. v. Feil*, 774 F.2d 1132, 1138.

Furthermore, as detailed in the previous response, the Applicants maintain that Runyon et al. as been improperly combined with Besemer et al. because Runyon et al. is not in the field of the Applicants' endeavor and is not reasonably pertinent to the particular problem that is the concern of the invention. Runyon et al. is concerned with packaging electronic devices and as such is not the field of Applicants' endeavor. The problem to which the invention is directed is the "need for a more economical packaging method and system for microarrays with features that facilitate automated processing and handling of microarrays" (last sentence of the Background section). Part of the solution to this need is to provide sealed chambers for each microarray in the multiple-pocket strip that can accept and hold fluids (or gasses) without leaking. As such, Runyon et al. is not reasonably pertinent to the particular problem being solved by the invention. As such, Runyon et al. is not properly combinable with Besemer et al.

Accordingly, in making the rejection of the claims over Besemer et al. in view of Runyon et al., the Examiner has improperly combined these references, there being no motivation or suggestion to do so and the two references being from unrelated fields.

Finally, the Applicants again submit that even if Besemer et al. and Runyon et al. were properly combinable, an objective combination of these references would result in the entire rigid microarray housing of Besemer et al. being packaged for shipment into the electronic component carrier taught in Runyon et al. This clearly does not arrive at the claimed invention because the arrays would still be housed in the rigid device of Besemer et al. and not in sealed chambers that are the product of a non-rigid cover strip and the pocket strip.

In summary, the Applicants submit that the cited references fail to establish a *prima facie* case of obviousness and as such respectfully request withdrawal of the rejection of Claims 1 – 8, 10 – 21, 32 and 33 under 35 U.S.C. § 103(a).

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CONCLUSION

In view of the remarks above, the Applicants respectfully submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone Dianne Rees at (650) 485-5999. The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16 and 1.17 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 50-1078 order number 10004032-1.

Respectfully submitted,

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